



217720US3

IN THE UNITED STATES PATENT & TRADEMARK OFFICE

IN RE APPLICATION OF :
Masaharu NISHIMURA, et al. : EXAMINER: KIM, T.
SERIAL NO: 10/023,702 :
FILED: December 21, 2001 : GROUP ART UNIT: 3746
FOR: GAS TURBINE COMBUSTOR :

Election
#51
7/3/03
N. Flewler

PROVISIONAL ELECTION OF SPECIES

COMMISSIONER FOR PATENTS
ALEXANDRIA, VIRGINIA 22313

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SIR:

In response to the Office Action dated May 29, 2003, Applicants elect with traverse Species IV, examples of which are shown in Figure 4, of the application. Accordingly, Applicants identify Claims 1-5 as readable on the provisionally elected species. Applicants further respectfully concur with the Examiner's determination that independent Claim 1 is generic.

Applicants respectfully traverse the outstanding requirement for several reasons.

First, the outstanding Office Action merely includes the conclusory statement that "[t]his application contains claims directed to the following patentably distinct species" without stating any basis whatsoever in support of such a finding. This is in violation of MPEP § 816, which states:

The particular reasons relied on by the examiner for holding the inventions as claimed are either independent or distinct

inadequate. The reasons upon which the conclusion is based should be given.

In the absence of any annunciated basis, it is respectfully submitted that the PTO clearly has not carried forward its burden of proof to establish distinctness.

Secondly, MPEP § 806.04(f) requires:

Claims to be restricted to different species must be mutually exclusive.

The outstanding Official Action fails to address in any way whether the pending claims recite mutually exclusive characteristics and this failure provides a further basis for traversing the election of species requirement.

Finally, MPEP § 803 states:

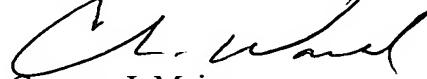
If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to distinct or independent inventions.

The claims of the present invention would appear to be part of an overlapping search area. Accordingly, Applicants also respectfully traverse the outstanding requirement on the grounds that a search and examination of the entire application would not place a *serious* burden on the Examiner.

Therefore, it is respectfully requested that the requirement to elect a single species be withdrawn, and that a full examination on the merits of Claims 1-11 be conducted.

Respectfully submitted,

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